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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
IDEV:020US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on n/a Electronically Filed

Signature

Typed or printed name

Application Number	Filed
10/092,385	March 5, 2002
First Named Inventor	
Jeffery J. Sheldon	
Art Unit	**Examiner**
3773	Darwin P. Erezo

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number 44,699

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Mark T. Garrett/
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December 1, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

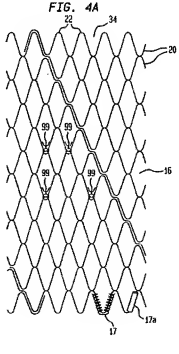
☐ *Total of _____ forms are submitted.

Arguments in Support of Pre-Appeal Brief Conference Request for 10/092,385

The Office rejects claims 1, 2, 25, and 26 as being obvious over US 5,716,365 to Goicoechea *et al.* in view of US 6,340,367 to Stinson *et al.* These rejections lack factual and legal support and should be withdrawn.

Each of these claims involves at least two crossed strands, as explained on pages 5-6 of the January 25, 2008 Response. Goicoechea fails to disclose a stent that involves crossed strands that are secured together. The Goicoechea stent is instead formed by winding distinct parts of the stent (such as proximal part 12, and frustoconical parts 14 and 18) using separate, single wires, each of which is wrapped around a mandrel containing pins located around the mandrel's circumference in a zig-zag pattern and spaced longitudinally along the surface of the mandrel to produce various "hoop" regions that lie in planes perpendicular to the longitudinal axis of the mandrel. These parts are then secured to each other by securing together some or all of the juxtaposed apices 22 of neighboring hoops 20 using securing means 99 such as polypropylene filaments:

FIG. 4A



See col. 8, line 59 – col. 10, line 12.

The Office contends that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the methodology of Goicoechea to include securing crossing strands [as in Stinson] instead of just strands having juxtaposed apices ***because tying a securing element between any strands will enhance the security of the tubular structure (stent)***." Action at pp. 3-4 (emphasis added). However, in order to "secure[] crossing strands" in Goicoechea, as the Office proposed, Goicoechea's stent must first be ***re-designed to possess*** crossed strands. As explained in the last response on pages 7-9, there is no logical reason why one of ordinary skill in the art would alter Goicoechea so drastically for any reason, much less to "enhance the security of the tubular structure (stent)," which is not an issue in Goicoechea. Specifically, the last response cites to a declaration from the inventor in which he explains why: (1) introducing crossed strands into the non-woven stent of Goicoechea would require a completely new stent design that departs significantly from Goicoechea's described stent design, see Rule 132 Declaration of Jeffery J. Sheldon at ¶¶ 2-6; and (2) the Office's purported reason for altering Goicoechea (security enhancement) makes no sense in light of the teachings of either reference, *id.* at ¶¶ 7-8.

The Office's response on pages 5 and 6 is legally flawed. It contends first that "it would have been obvious to modify the device of Goicoechea to include crossed strands since it has been held that the use of a known technique (forming crossed strands) to improve similar devices (stents) will provide predictable results." Action at p. 5 (citation to *KSR* omitted). Respectfully, the Office has not shown any support for the assumptions underlying its logic. Nothing in Stinson suggests that the stent formation method disclosed there is an improvement over the stent formation method disclosed in Goicoechea. Rather, Stinson appears to concern increasing

radiopacity (see, e.g., Stinson's Summary) while Goicoechea appears to concern joining stents together (see, e.g., Goicoiechea's claims). The Office's remaining conclusory statements on pages 5 and 6 do not provide a rational basis for doing what the Office suggests: re-designing Goicoechea for no reason. *KSR* mandates a reasoned, common sense approach to obviousness that is simply missing from the Office's Action. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing with approval to *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), in which the Federal Circuit explained that conclusory statements that are supported by a rational underpinning will not support the legal conclusion of obviousness). For these reasons, the rejections should be withdrawn.

The Office also rejects claims 12 and 14 as being obvious over Goicoechea in view of Stinson as applied to claim 1, and further in view of The Ashley Book of Knots. The combination of Goicoechea and Stinson as applied to claim 1 fails for the reasons above. The Ashley Book of Knots does not remedy that failure. Accordingly, the rejection is overcome and should be withdrawn.